

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ANDREW E. FANO and SCOTT KURTH

MAILED  
JUL 31 2006  
PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 09/520,943

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on July 13, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

On August 10, 2005, appellants filed an amendment in response to an Office action mailed January 13, 2005. A review of the file reveals that it is not clear from the record whether the examiner considered the amendment. Before further review, the examiner must consider the amendment filed on August 10, 2005.

Also, in the claims section of the amendment filed August 10, 2005, claim 103 was canceled. However, in the Status of Claims and Appendix of Claims sections of the appeal brief filed August 12, 2005, claim 104 is indicated as canceled. After consideration of the amendment

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by the examiner, the examiner must require appellants to provide a clear indication to which of the two claims (103 and 104) is the canceled claim in a substitute appeal brief. Appropriate correction is required.

In addition, the examiner has mailed an examiner's answer on November 7, 2005. In the Evidence Relied Upon section, page 3, paragraph (8), the examiner has stated, "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that the reference to Jones, 6,021,397 was applied to the statement of rejections in the Grounds of Rejection section of the examiner's answer. Before further review, the examiner must submit a corrected examiner's answer that will include in the Evidence Relied Upon section, the reference to Jones, 6,021,397 mentioned in the statement of rejections. See the Manual of Patent Examining Procedure (MPEP) §1207.02, page 1200-29.

Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) consider the amendment filed August 10, 2005; 2) request appellants to file a substitute appeal brief that will reflect the appropriate changes to the status of claims 103 and 104; 3) vacate the examiner's

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answer and issue a revised examiner's answer having the missing references listed under the Evidence Relied Upon section; and 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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